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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,442	10/17/2002	Rick L. Pruter	02P1604	8676

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EXAMINER

JAIN, RUBY

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 02/13/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,442

Applicant(s)

PRUTER, RICK L.

Examiner

Ruby Jain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1-21 of this application conflict with claims 1-21 of Application No. 10/065758. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-21 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-21 of copending Application No. 10/065758. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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Applicant's counsel is respectfully reminded that if the scope of one of the applications is changed, this may lead to a provisional type double-patenting rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because the relationship of attaching and detaching the needle guide is never stated fully. Only the step of detaching is claimed and it is not previously state that the needle guide was even attached.

Claim 17 is vague and indefinite because a medical instrument does not necessarily refer to a needle guide central cannula section. "A medical instrument" should be recited as -- a needle guide central cannula section -- to maintain consistency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. U.S. Patent No. 5,758,650.

Regarding claim 1, Miller discloses wherein a medical imaging system comprises of:

- 1) a transceiver bracket being sized and shaped to secure with an imaging transceiver (118)
- 2) the transceiver/bracket covers the sterile sheath disposed over the imaging transceiver (column 5, lines 10-25)
- 3) a needle guide disposed over the transceiver/bracket (112)
- 4) a lock comprising a void in the transceiver bracket and a first pliable clamp leg allowing needle guide to be detached (Figure 1)

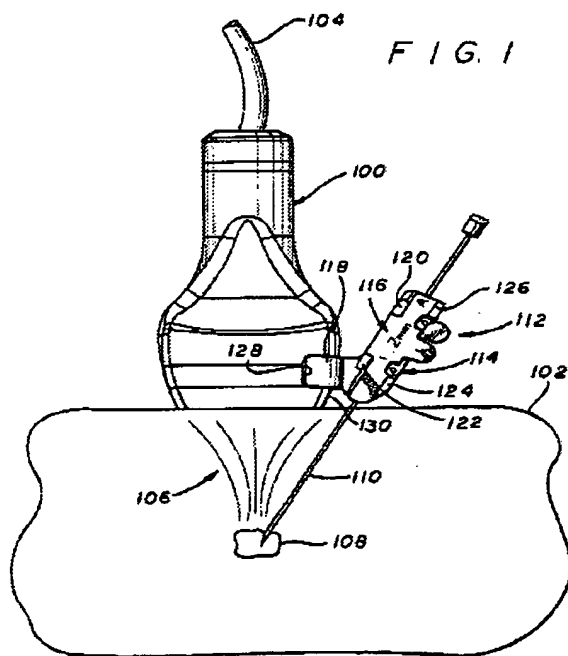


FIG. 2

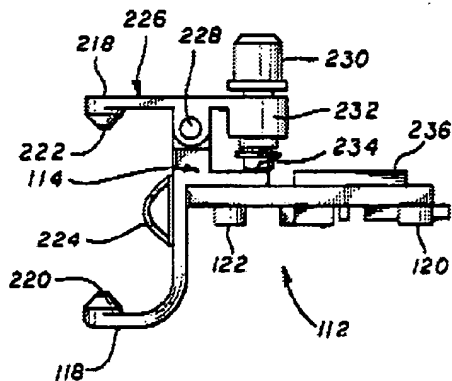
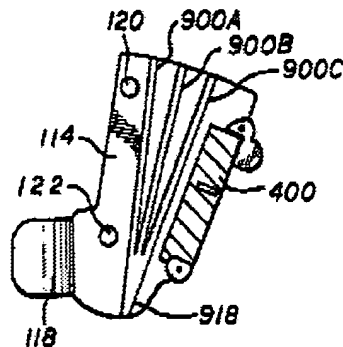


FIG. 9



Regarding claim 2, Miller discloses wherein the first side clamp leg is coupled to a needle guide (Figure 2).

Regarding claims 3 and 4, Miller discloses wherein a second clamp leg is disposed on an opposing side with a leg protuberance (220) (Figure 2).

Regarding claim 5, Miller discloses wherein the needle guide is configured to receive needles at various locations and angles (Figure 9).

Regarding claim 6, Miller discloses wherein the needle guide an enlarged end, facilitating grasping of the needle guide (Figure 1).

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5. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Pruter U.S. Patent No. 6,296,614.

Regarding claim 20, Pruter discloses wherein a system for guiding needles comprises: a endocavity imaging transceiver (4), a mounting bracket, with a partial sleeve shape, coupled to the transceiver (6), a mounting bracket protuberance receiving void therein (Figure 2), a needle guide and receiving area (12), a side clamp leg with a clamp protuberance configured to mate with mounting bracket (36 and 22), the protuberance has a strength characteristic insufficient to keep side clamp leg intact when needle guide removed (column 4, lines 36-62).

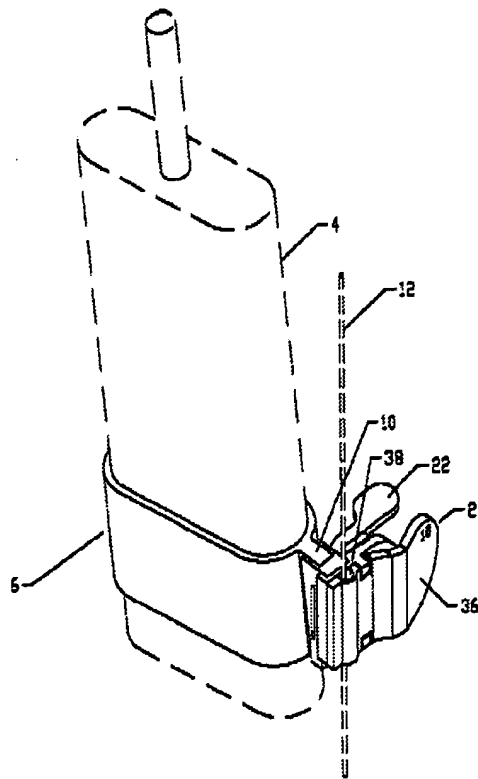


FIGURE 1

Claim Rejections - 35 USC § 103

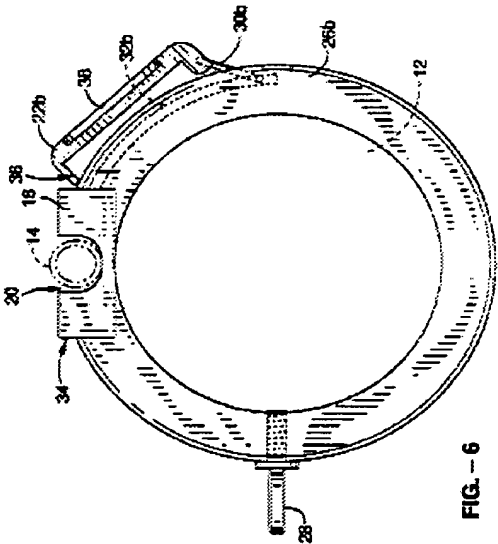
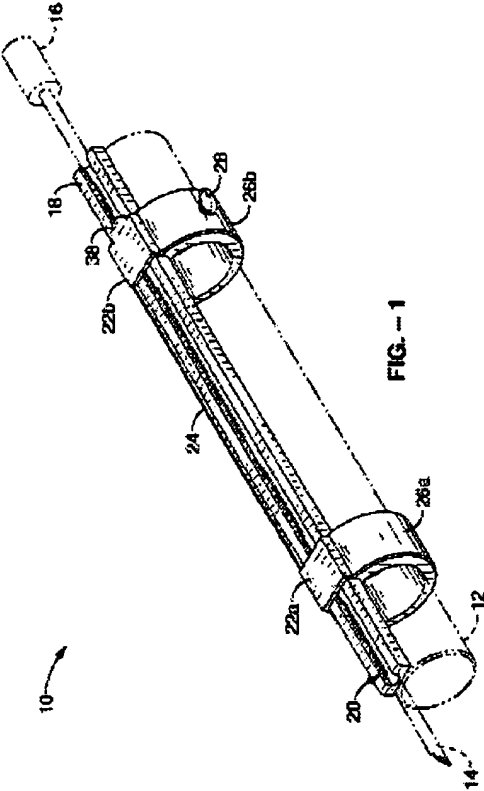
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGahan U.S. Patent No. 6,095,981.

Regarding claims 7, 17, 19, and 21, McGahan discloses wherein an endocavity imaging system comprises of an endocavity imaging transceiver (abstract), a mounting bracket coupled to the imaging transceiver (26 a and b), a needle guide coupled with the mounting bracket so as to create a lock between the needle guide and mounting bracket (18). McGahan does not disclose wherein the lock is a single use lock incapable of affixing the needle guide to the mounting bracket.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to disclose wherein the lock is a single use lock incapable of affixing the needle guide to the mounting bracket because to facilitate opening of cover 22b, a proximal tab is disclosed for applying a radial force. With continuous use, it is inherent that the tab will break off and thereafter is incapable of affixing the needle to the mounting bracket.



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Regarding claims 8 and 18, McGahan discloses wherein the lock comprises a plurality of protuberances (34) which mates with a void to lock (Figure 6).

Regarding claim 9, McGahan discloses wherein the structure is a void in the mounting bracket (Figure 6).

Regarding claim 10, McGahan discloses wherein the needle guide central cannula section is recessed in a mounting bracket needle guide-receiving slot (18) (Figure 1).

Regarding claim 11, McGahan discloses wherein the mounting bracket is a partial sleeve disposed about a reduced cross-section imaging transceiver (Figures 1 and 6).

Regarding claim 12, McGahan discloses wherein the partial sleeve is sized to provide a clamping force as to secure the partial sleeve (Figure 1).

Regarding claims 13 and 14, McGahan discloses wherein the needle guide is configured to apply a needle guide clamping force (column 3, lines 28-48).

Regarding claims 15 and 16, McGahan discloses a plurality of protuberances with strength characteristics (column 4, lines 12-23, and Figures 1 and 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruby Jain whose telephone number is (703) 605-4250. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJ


February 7, 2004


DENNIS W. RUHL
SUPERVISORY PATENT EXAMINER